

## **REMARKS**

### **REMARKS/ARGUMENTS**

Claims 1-19 are pending in the application and have been rejected. Claims 1, 2, 4-6, 9-11, 14, 17, and 18 have been amended. Applicant respectfully requests reconsideration.

#### **Rejections under 35 U.S.C. §102.**

The Office Action has rejected claims 1-6 and 9-19 under 35 U.S.C. §102 as being anticipated by US Patent No. 6,415,359 issued to Kimura et al. (hereafter, "Kimura"). Applicant respectfully traverses the rejection for the following reasons.

Claim 1 requires storing only *strategically selected storage data* in the second level of storage based on energy-conserving criteria. Kimura neither teaches nor suggests this feature. The Office Action cites col. 4, lines 16-25 and the Abstract of Kimura for this element. However that part of Kimura does not discuss any strategically selected storage data.

Claims 2-15 are either directly or indirectly dependent on claim 1 and are patentable for at least the same reasons that claim 1 is patentable.

Claim 16 recites a controller for storing only strategically selected storage data in the second level of storage. As noted above Kimura does not teach or suggest storing only strategically selected storage data. Therefore claim 16 is not anticipated by Kimura.

Claim 17 relates to a method for managing storage of information and includes a step of storing only strategically selected storage data in managed storage. Kimura does not teach or suggest storing only strategically selected storage data. Therefore claim 17 is not anticipated by Kimura.

Claim 18 relates to a computer readable medium and includes an element of storing only strategically selected storage data in managed storage. Kimura does not teach or suggest storing only strategically selected storage data. Therefore claim 18 is not anticipated by Kimura.

Claim 19 recites an information handling system that includes an arbiter for storing only strategically selected storage data in second level storage. Kimura does not teach or suggest

storing only strategically selected storage data. Therefore claim 19 is not anticipated by Kimura.

**Rejections under 35 U.S.C. §103.**

The Office Action rejected claims 7 and 8 as unpatentable over Kimura in view of Thelander (U. S. Patent Application 2003/0009705). The Office Action concedes that Kimura is silent on "system stores current user profiles and the system state information comprises whether storage input/output data are associated with a current user profile." However, the Office Action contends that Thelander teaches this element and that it would have been obvious to one skilled in the art to modify Kimura according to Thelander such that the limitations of claim 7 are met. The motivation cited for making the combination is that "the power magnitude profile may include multiple power settings or power schemes with the same schedule, so that the user may select between different power settings or schemes to be implemented." Page 10 of the Office Action. The Office Action cites paragraph 48 of Thelander for this motivation. Paragraph 48 reads:

"With some embodiments of the invention, the power management profile may include multiple power settings or power schemes with the same schedule, so that the user may select between different power settings or schemes to be implemented during the scheduled time period. In these embodiments, the client unit 303 may cause the operating system to implement a default power setting or scheme for the scheduled period according to any desired criteria, such as having a preselected default setting or scheme, or using the setting or scheme most recently selected by the user. Also, with some embodiments of the invention, the power management profile may allow any user (or one or more specified users) to modify or override parameters of the profile. With these embodiments, the interface 401 may, for example, permit the user to modify the settings in fields 445 and/or 447 and 449, or provide an override button that allows the user to override implementation of the power management profile."

As the quoted section reveals, Thelander concerns a power management profile and not a user profile. Thelander does not suggest the second part of claim 7 either. There is no discussion in Thelander of the system state information comprising storage input/output data associated with a current user profile. Therefore, Thelander does not suggest or motivate the modification of Kimura as suggested by the Office Action.

With respect to claim 8, the Office Action also contends that "the combination of Kimura and Thelander teach, wherein the system stores current user preferences and the system state information comprises whether storage input/output data are associated with current user preferences." The above-quoted part of Thelander is cited in support of this finding. However, neither Kimura nor Thelander teach, suggest or motivate the caching of only strategic information for power savings.

Therefore, Applicant respectfully submits that claims 7 and 8 would not have been obvious in view of the combination of Kimura and Thelander. The concept of storing only strategically selected information is not taught or suggested in the combination of references. Thelander contains no teaching or motivation to modify Kimura as suggested by the Examiner.

Claim 11 has been rejected under 35 USC §103 as being obvious over Kimura in view of Applicant's admitted prior art. The Office Action concedes that Kimura does not disclose the use of Flash memory for the second levels of storage hierarchy. Claim 11 is dependent on claim 1 and is patentable for the same reasons as claim 1. Applicant has not admitted that the claimed combination is old. The statement made in the Background is "These media *could be* alternate non-volatile memory such as Flash memory, ...(emphasis added)". That is a statement of possible solutions not an admission that those devices exist. The mere existence of Flash memories does not establish the obviousness of using the Flash memories in the combination of claim 8. The claimed subject matter must be considered as a whole. 35 USC §103.

Claim 12 has been rejected under 35 USC §103 as being obvious over Kimura in view of Atkinson (US Patent 6,029,249). Claim 12 is indirectly dependent on claim 1 and is patentable for at least the same reasons discussed herein with respect to claim 1.

Serial No. 10/674,926  
Filed: 09/30/2003  
AMENDMENT



For the foregoing reasons, Applicant respectfully requests allowance of the pending claims and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

Michael J. Buchenhorner  
Michael J. Buchenhorner  
Reg. No. 33,162

Date: October 2, 2006

**Certificate of First Class Mailing**

I hereby certify that this Preliminary Amendment, and any documents referred to as attached therein, are being deposited in the U. S. Post Office as first-class mail on this date, October 2, 2006, to the Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

Michael J. Buchenhorner  
Michael J. Buchenhorner

Date: October 2, 2006